

REMARKS

Reconsideration of the above application is respectfully requested.

Claims 1-23 are pending. Claim 16 has been amended. These amendments add no new matter. Claims 1-23 are subject to restriction. Claims 1-15 and 21-23 are withdrawn from consideration as being drawn to a non-elected invention. Upon entry of this amendment, Claims 16-20 are pending.

A. ELECTION/RESTRICTION

The Examiner has required restriction of the claims to one of four groups:

Group I – Claim 3;

Group II – Claims 2 and 4-12;

Group III – Claims none; and

Group IV – Claims 16-20.

Applicants hereby confirm the provisional election of the claims of Group IV (Claims 16-20) for initial examination.

B. CONTINUING DATA

In said Official Action, the Examiner has instructed Applicants to insert the continuing data. The Examiner's instruction is acknowledged and the specification has been amended in accordance with the Examiner's instruction.

C. CLAIM REJECTIONS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

The Examiner has rejected Claims 16-20 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Examiner's two separate grounds of rejections and Applicants' responses thereto are detailed below.

1. The Phrase "a medical condition of the type characterized by the destruction of articular cartilage"

The Examiner has rejected Claims 16-20 on the grounds that the phrase "a medical condition of the type characterized by the destruction of articular cartilage" called for in these claims is allegedly indefinite. The Examiner argues that Claims 16-20 merely cite a use without any active, positive steps delimiting how to practice this use.

Applicants respectfully traverse the Examiner's rejection on the grounds that the phrase "a medical condition of the type characterized by the destruction of articular cartilage" fully complies with 35 U.S.C. § 112 second paragraph. Applicants submit that Claims 16-20 cannot be indefinite because one of ordinary skill in the art

understands what this phrase means. This is in contrast with the Examiner's unsupported premise in the Official Action that the diseases Applicants intend to cover under this phrase would involve extensive and potentially inconclusive clinical research. Applicants submit that according to M.P.E.P. § 2164.08, claims are interpreted in light of the specification. M.P.E.P. § 2164.08 states:

"When analyzing the scope of a claim, the teachings of the specification must not be ignored because claims are to be given their broadest reasonable interpretation that is consistent with the specification. 'That claims are interpreted in light of the specification does not mean that everything in the specification must be read into the claims' Raytheon Co. V. Roper Corp., 724 F.2d 951, 957, 220 USPQ 592, 597 (Fed. Cir. 1983)".

Applicants have stated throughout the application as originally filed that a condition of the type characterized by the destruction of articular cartilage includes joint injury, reactive arthritis, acute pyrophosphate arthritis (pseudogout), psoriatic arthritis, osteoarthritis or juvenile rheumatoid arthritis (see page 8, lines 21-28; page 9, lines 7-11; page 10, lines 27-31; page 12, lines 5-9; page 13, lines 19-23; page 14, lines 35 to page 15, line 2; and page 63, lines 14-19 of the specification). Further, numerous clinical trials have been performed specifically detailing the biochemistry of destruction of cartilage. Applicants have also provided four different assays for the conditions associated with the claimed molecules (see specification, page 61-55). The affinity, agonist activities and analgesic activity were demonstrated by assays and tabulated in the specification (see specification, page 53, 55, 56-62 (Table 2)). The specification recites appropriate dosages, see page 63, lines 29-34. Because the specification has provided every component necessary to treat the claimed condition, based on the above cited M.P.E.P. § 2164.08, and have demonstrated a reasonableness of success, Claim 16 interpreted in light of the specification is readily understood by those skilled in the art and is thus definite.

2. The Phrase "a small molecule"

The Examiner has rejected Claims 16-20 on the grounds that the phrase "a small molecule" called for in these claims is allegedly indefinite. The Examiner requested that the phrase molecular size be amended to recite volume, length, atomic number of constituent, or complexity.

Applicants respectfully traverse on the following grounds. Applicants submit that according to the above cited M.P.E.P. § 2164.08, claims are interpreted in light of the specification. Applicants have defined the phrase "a small molecule" in the

specification. The Examiner's attention is directed to the specification, page 13, lines 25-30, which states "A small molecule, as used herein, refers to non-DNA, non-RNA, non polypeptide, and non-monoclonal antibody molecules with a molecular weight of under 2000 grams/mole". However, notwithstanding the clarity of the term "a small molecule", to execute prosecution and for early allowance, Applicants have amended Claim 16 to refer to the molecular weight of the claimed small molecule. Applicants request that the Examiner remove this ground of rejection.

In summary, Applicants respectfully submit that the amendment to Claim 16 has obviated the Examiner's indefiniteness rejection and therefore respectfully request that the rejection be withdrawn.

D. AMENDMENT OF CLAIM 16 FOR FORMALITY

Applicants respectfully submit that Claim 16 has also been amended to correct an obvious typographical error. Specifically, the comma in between the term "having" and the term "said condition" in the original Claim 16, line 3, has been deleted. Support for this amendment can be found in the specification, page 13, lines 19-23.

E. ALLOWABLE CLAIMS

The Examiner has stated that Claims 6-10 would be allowable if rewritten to overcome the above indefiniteness rejections. Because, upon entry of this amendment, claims 1-15 and 21-23 are withdrawn from consideration as being drawn to a non-elected invention, Applicants submit that they reserve the right to prosecute these claims in a divisional application.

F. CONCLUSION

Applicants submit that pending Claims 16-20 are patentable, and respectfully request that they be allowed to issue.

Respectfully submitted,

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